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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,584	06/01/2001	Frank W. Sudia	P 264493 AUTH-II	9326
909	7590	01/04/2005	EXAMINER	
PILLSBURY WINTHROP, LLP			SEAL, JAMES	
P.O. BOX 10500				
MCLEAN, VA 22102			ART UNIT	PAPER NUMBER

2135

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/870,584

Applicant(s)

SUDIA ET AL.

Examiner

James Seal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 18-71 is/are pending in the application.
- 4a) Of the above claim(s) 22-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 18, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant amended claim 1, added claims 18-71 in the amendment filed 6/9/04. New claims 18021 depend on claim 1. New claims 22-71 constitute distinguished claimed inventions from the original presentation of claim 1.

Newly submitted claims 22-71 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 22-71 are drawn to a commercial transaction having checking the attribute, checking the sponsor, determining to allow the transaction, which are classified in Class 705/53. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-71 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,21 are rejected under 35 U.S.C. 102(e) as being anticipated by Muftic (US 5,745,574).

Claim 1: Muftic's patent discloses certifying authority issues digital certificate identifying users of system in (fig.26). Muftic discloses digital certificates being digitally signed with a private key of certifying authority to form a digital signature and requiring a public key of certifying authority in order to verify digital signature in (col.14,lines 54-63). Muftic discloses a

user transaction in cryptographic system requires verification by a recipient of user transaction, verification based on information in digital certificates and requiring the public key in (col.10,lines 34-49). Muftic discloses denying access to public key in (col.4,lines 65-67;col.5,lines 1-2). Muftic discloses providing recipient with at least one message containing rules of system including a rule regarding maintaining secrecy of public key in (col.10, lines 52-57). Muftic discloses digitally signing by recipient at least one message which recipient agrees to rules and permitting recipient to utilize public key in (col.11, lines 29-53;col.12, lines 32-40).

Claim 21: Muftic discloses user transaction is invalid until digital signing is performed in (coll.12, lines 22-43).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic (US 5,745,574) in view of Curry et al.(US 5,940,510).

Claim 18: Muftic does not specifically disclose providing recipient with a secure device containing public key, wherein public key cannot be obtained from secure device. Curry's patent discloses secure device containing public key, wherein public key cannot be obtained from secure device in (col.4, lines 49-55). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ secure device containing public key wherein public key cannot be obtained from secure device as taught in Curry with public key storage of Muftic

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in so that key can be protected and secured at all times against tampering/malicious attacks thus providing secure means to conduct transaction by the users.

Claim 20, Muftic discloses containing rules of system including a rule regarding maintaining secrecy of public key. Muftic does not include a rule to pay for use by said recipient of intellectual property provided through the system. Curry teaches the monetary value of the recipient is decreased (paying) for the use of the system when information is matched (rule), col. 7, lines 21-.35). It would have been obvious to person of ordinary skill in the art at the time invention was made to include a rule to pay as taught in Curry to the system in Muftic in order to provide recipient's privileges and conveniences for the use of the system.

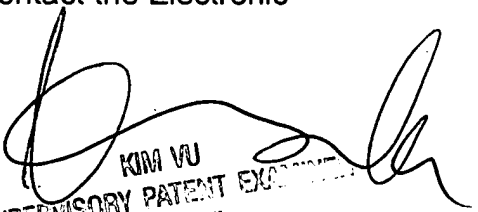
***Allowable Subject Matter***

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Seal whose telephone number is 571-272-3855. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
KIM YU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER